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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/391,294 09/07/99 WILSON

R CBC-122-C

EXAMINER

PM82/0503

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ART UNIT

PAPER NUMBER

3635

DATE MAILED:

05/03/00

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/391,294

Applicant(s)
Wilson et al.

Examiner
Robert Canfield

Group Art Unit
3635



☒ Responsive to communication(s) filed on Mar 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This is a Supplemental Office action on the merits for reissue application S.N. 09/391294 filed 09/07/99. This action is in response to the preliminary amendment filed 03/21/00. Claims 1-23 are pending. The period for reply starts with the mailing date of this Supplemental Office action.

2. The examiner acknowledges the letter stating that U.S. Patent 5,664,736 is involved in litigation. During a telephone conversation with Darlene Condra on 03/14/00 the examiner was informed that it was applicant's desire that the application be examined at this time.

3. The examiner acknowledges receipt of the IDS filed 12/20/99. An initialed copy of the 1449 forms is attached.

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

It fails to properly identify the specification to which it is directed as required by 37 CFR 1.63(a)(2). The declaration refers to U.S. Patent 5,542,222 not U.S. Patent 5,664,736.

It fails to identify each inventor's residence and post office address as required in 37 CFR 1.63(a)(3),

It fails to recite that the inventors are joint inventors as required by 37 CFR 1.63(a)(4),

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It fails to provide a statement that the person signing has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the declaration as required by 37 CFR 1.63(b)(1),

It fails to state that the persons signing believe the named inventor or inventors to be the original and first inventors of the subject matter which is claimed and for which a patent is sought as required by 37 CFR 1.63(b)(3),

It fails to state that the person signing acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 as required by 37 CFR 1.63(b)(3).

5. Claims 1-23 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. Claims 1-23 are rejected under 35 U.S.C. 251 as lacking basis for reissue, because by statute a reissue application can only be granted for the unexpired portion of the term of the original patent. In re Morgan, 990 F 2d. 1230, 26 USPQ2d 1392 (Fed. Cir. 1983), which holds that reissue applications can only be issued for unexpired patents.

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There is no record of the 3.5 year maintenance fee being paid for U.S. Patent 5,542,222 of which the term of U.S. Patent 5,664,376 shall not extend beyond.

7. Claims 5-23 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitations "single member" and/or "wherein said first and second longitudinally extending portions have lengths corresponding to the length of the corner of the building" have been omitted from the claims. These limitations were presented in amendments in application serial number 08/639698 filed on 04/29/96 and 12/06/96. Applicant's remarks in these amendments contains arguments that these limitations make the claims allowable over the prior art

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of record. Thus, the omitted limitations relate to subject matter previously surrendered, in application serial number 08/639698.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-8, 12, and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claims is rendered indefinite by the language “have lengths corresponding to the length of the corner of the building” and “has a length and thickness corresponding to and for filling the hollow space between the corner post and external wall of the building”.

The preamble of the claim recites that a support member is being claimed *for* a corner post and used *to* enclose the external corner of an external wall of a building. This implies that the support member is being claimed alone in subcombination with the corner post and building presented as an intended use environment.

The language in question defines dimensions of the support member by direct relationships to the intended use environment. A subcombination claim cannot be defined by direct relationships to its intended use environment as the claim then becomes indefinite. Any

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relationships to then intended use environment must be made functionally. Applicant is attempting to claim the support member alone, not in combination with the corner post and building, but has defined it with direct relationships to these elements. The inconsistency between the preamble and the body of the claims renders the intended scope of the claims indefinite.

In claim 5, "the first plane" at lines 8 and 9 lacks a proper antecedent basis.

In claim 17, "said single member" at lines 10 and 11 lacks a proper antecedent basis.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,455,797 to Naka.

See the embodiment of figure 4. A member 51 fabricated from a material having insulating qualities (extruded synthetic resin) is provided for extending along an external corner of a building structure. The member has first and second portions lying in angularly disposed planes for contacting the external corner and spaced apart outer surfaces. Each portion has an radially outwardly extending flange 13.

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As best understood applicant is attempting to claim the support member alone in subcombination with the building and corner presented as an intended use environment. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Naka meets each of the structural elements recited in the claims.

12. Claims 1, 5, 9, 13, 17, 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,091,316 to Hauck.

Hauck provides in figure 2 a member 6 having first and second longitudinally extending portions defining a cornered inner surface each having a radially outwardly extending flange 5. Again note that the claims are considered to be drawn to the member alone not in combination with a building and corner post.

13. Claims 1, 5, 9, 13, 17, 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,430,833 to Balzer et al.

See the embodiment in figure 8. A member is provided having first and second longitudinally extending portions angularly disposed and defining an inner cornered surface at approximately 146 in figure 8 for contacting a building. The portions have spaced apart cornered outer surface at 150/154 for contacting a corner post 120. Each portion has a radially outwardly extending flange at approximately 125.

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14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3, 4, 7, 8, 11, 12, 15, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,455,797 to Naka.

Naka provides each of the elements of these claims except that the material selected is polystyrene foam and the thickness of the member.

Naka recites that the material selected for the member be an extruded synthetic resin.

One of ordinary skill in the art would have recognized extruded polystyrene foam as a synthetic resin at the time of the invention. Polystyrene foam would have been an obvious choice of material at the time of the invention to one having ordinary skill in the art for the member of Naka as it falls within the broader materials suggested by Naka of a synthetic resin. Polystyrene is well recognized in the building construction arts as a material choice where synthetic resins are used for its inherent material properties such as insulating properties and ease in extruding.

The thickness of the member of Naka is a choice of design which would have been obvious to one having ordinary skill in the art. One of ordinary skill in the art would have readily recognized that the thickness of the member of Naka could have been modified to be used with

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stairs, nosings and carpets of different sizes. Changes in size do not support patentability. See MPEP 2144.04.

16. Applicant is advised that should claims 13, 14, and 17 be found allowable, claims 21-23 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 21-23 are substantial duplicates to claims 13, 14 and 17. There is only a slight difference in wording.

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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18. Claims 1-23 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 5542222 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a support member having first and second longitudinally extending portions, the first portion lying in a first plane angularly disposed to the second portion lying in a second plane, the support member formed from a material having insulating qualities (polystyrene foam) and the first and second portions having respective first and second support member flanges extending longitudinally and radially outward.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Canfield whose telephone number is (703) 308-2482. The examiner can normally be reached on M-Th.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2138.

Robert Canfield

March 20, 2000

Robert Canfield
Primary Examiner